

#17
EV058762505

PTO/SB/17 (10-01)

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 320.00

Complete if Known

Application Number	09/191,047
Filing Date	Nov 12, 1998
First Named Inventor	Zuberec
Examiner Name	Armstrong, A.
Group Art Unit	2741
Attorney Docket No.	MS1-286US

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 12-0769
Deposit Account Name: Lee & Hayes, PLLC

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17
☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☐ Payment Enclosed:

☐ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	
SUBTOTAL (1)					(\$) 0.00

2. EXTRA CLAIM FEES

Total Claims: - 20** = X =
Independent Claims: - 3** = X =
Multiple Dependent: =

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
103	18	203	9	Claims in excess of 20	
102	84	202	42	Independent claims in excess of 3	
104	280	204	140	Multiple dependent claim, if not paid	
109	84	209	42	** Reissue independent claims over original patent	
110	18	210	9	** Reissue claims in excess of 20 and over original patent	
SUBTOTAL (2)					(\$) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for ex parte reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 320.00

SUBMITTED BY

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Date 7/18/02

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PTO/SB/21 (08-00)

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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<h1>TRANSMITTAL FORM</h1> <p>(to be used for all correspondence after initial filing)</p>	Application Number	09/191,047	RECEIVED JUL 23 2002 Technology Center 2600
	Filing Date	Nov 12, 1998	
	First Named Inventor	Zuberec et al.	
	Group Art Unit	2654	
	Examiner Name	Armstrong, A.	
Total Number of Pages in This Submission	Attorney Docket Number	MS1-286US	

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) Sheets <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return postcard Reply Brief Before the Board of Patent Appeals and Interferences (in triplicate)
<div style="display: flex; justify-content: space-between;"> <div>Remarks</div> <div style="text-align: center;">  22801 PATENT TRADEMARK OFFICE </div> <div style="writing-mode: vertical-rl; transform: rotate(180deg);"> BOARD OF PATENT APPEALS AND INTERFERENCES JUL 23 2002 PM 1:39 </div> </div>		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Brian G. Hart, Reg. No. 44,421
Signature	by Daniel L. Hayes, Reg. No. 34,618
Date	7/18/02

CERTIFICATE OF EXPRESS MAILING		
I hereby certify that the items listed above as enclosed are being deposited with the U.S. Postal Service as Express Mail, in an envelope addressed to The Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the below-indicated date. The Express Mail No. has also been marked on the listed items. Express Mail No. EV058762505		
Typed or printed name	Cheryl K. Boies	
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#17

EV058762505

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No.09/191,047
Filing Date 11/12/1998
Inventorship.....Zuberec et al.
Appellant..... Microsoft Corporation
Group Art Unit2641
Examiner Armstrong, A.
Attorney's Docket No. MS1-286US
Title: Speech Recognition User Interface

REPLY BRIEF BEFORE THE BOARD OF PATENT APPEALS AND
INTERFERENCES

To: ***Box Appeal***
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From: Brian G. Hart (Tel. 509-324-9256; Fax 509-323-8979)

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REMARKS

Pursuant to 37 C.F.R. § 1.193, appellant hereby submits a reply brief to the examiner's answer, which was mailed on May 21, 2002 and hereinafter referred to as the "ANSWER". This reply brief does not provide a general rebuttal of each statement made in the ANSWER. Rather, the reply brief clearly and specifically addresses what the appellant believes are new grounds of rejection and new points of argument advanced by the ANSWER.

Groupings of Claims

As a preliminary matter with respect to groupings of claims, and as indicated in the March 04, 2002 Appeal Brief, which is hereby incorporated by reference and hereinafter referred to as the "APPEAL BRIEF", the following six (6) groups of pending claims were indicated as respectively standing or falling together:

1. Claims 1, 3, 5-6, 9, 12-14, 16-18, 20-26 stand or fall together.
2. Claims 4 and 11 stand or fall together.
3. Claims 7, 8, and 15 stand or fall together.
4. Claims 27-32 stand or fall together.
5. Claim 33 stands or falls by itself.
6. Claims 34-39 stand or fall together.

In addressing these six (6) claim groupings, the ANSWER concludes that claims 1, 3-9, 11-18, 20-35, 37, and 39 stand or fall together because the APPEAL

BRIEF did not include a statement that this grouping of claims does not stand or fall together, and reasons in support thereof. Appellant disagrees.

The APPEAL BRIEF explicitly presents 6 claim groupings, each group specifying a number of claims that stand or fall with respect to one another, not with respect to claims specified in other groups. Additionally, reasons in support of the separate patentability of claims within such grouping are provided to the extent that the claims are separately identified and argued for each ground of rejection contested in the “Arguments” section of the APPEAL BRIEF. Thus, contrary to the claim grouping suggested by the ANSWER, the claims stand or fall as indicated by claim groupings provided in the APPEAL BRIEF.

Improper New Grounds of Rejection in Examiner’s Answer

Claim 1 recites “the speech recognition engine being configured to enter a dormant state if the utterance is not recognized within the predetermined amount of time, the speech recognition system remaining in the dormant state until recognition of a starter word that is independent of the utterance”.

These recited features of claim 1 originally stood rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 6,018,711 to French St. George et al. (hereafter referred to as “St. George”) in view of U.S. Patent No. 5,774,841 to Salazar et al. (hereinafter referred to as “Salazar”). However, the ANSWER at page 10, paragraph 2, now concedes that St. George in view of Salazar fails to teach or suggest these recited features of claim 1. To provide these missing features of claim 1, the ANSWER now relies on the original combination of St. George in view of Salazar in addition to U.S. Patent No. 6,075,534 to VanBuskirk et al. (hereinafter referred to as “VanBuskirk”). (This combination is used to

provide new grounds of rejection not only with respect to claim 1, but also with respect to claims 9 and 27).

37 CFR 1.193(a)(2) expressly prohibits the entry of a new ground of rejection in an examiner's answer. The MPEP §1208.1 indicates that when a new ground of rejection is necessary, the examiner should reopen prosecution, not enter the new ground in the examiner's answer.

Nowhere have the previous rejections cited this combination of St. George in view of Salazar and further in view of VanBuskirk to arrive at the recited features of claims 1, 9 and 27. Thus, appellant respectfully asserts that the ANSWER states new grounds of rejection that are improper and should be overruled.

Moreover, combining VanBuskirk with St. George in view of Salazar does not cure the deficiencies of St. George in view of Salazar; such deficiencies being previously advanced with respect to the old grounds of rejection as well as with respect to the deficiencies of the cited references that are advanced below with respect to the new points of argument that have been presented by the ANSWER.

New Points of Argument in Examiner's Answer

Claim 1 further recites in part "a speech recognition engine to recognize an utterance", and "the speech recognition engine being configured to actively listen for the utterance for a predetermined response time". These features stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 6,018,711 to French St. George et al. (hereafter referred to as "St. George") in view of U.S. Patent No. 5,774,841 to Salazar et al. (hereinafter referred to as "Salazar"). The

deficiency of this rejection is readily apparent in view of the ANSWER's concession that St. George in view of Salazar does not teach or suggest all of the elements of claim 1, as stated with respect to the new grounds of rejection as discussed above. However, since new points of argument have been put forth in the ANSWER, appellant specifically rebuts these new arguments.

In addressing these features, the ANSWER at page 8, 2nd paragraph, newly modifies St. George to arrive at the above recited features. Specifically, the ANSWER argues that "if speech filling up the entire time period from 0 to T_w was recognized in a known duration, such as T_p , the total time $T_w + T_p$ would read on the broadly claimed "predetermined response time", as recited by claim 1. (See, St. George, col. 8, lines 28-30). Nowhere has the office previously presented such an argument against the patentability of the "the speech recognition engine being configured to actively listen for the utterance for a predetermined response time", as claim 1 recites. Thus, the ANSWER has stated new points of argument with respect to claim 1.

Moreover, the new points of argument of claim 1 are untenable for the reasons previously advanced in the APPEAL BRIEF, and because neither St. George nor Salazar, singly or in combination, teach or suggest the latest modification to St. George to arrive at the recited features of claim 1 (e.g., see the admission in the ANSWER at page 10, paragraph 2).

The APPEAL BRIEF as well as the November 20, 2001 response, which is also incorporated by reference, clearly indicates that aggregated sound input of St. George is not "recognized" until after it has been collected (i.e., the extendable window of time for collecting such input data has been closed). The ANSWER at

page 8, 2nd paragraph, 2nd sentence further admits that this is a proper interpretation of St. George. Accordingly, although St. George refers to the extendable window of time as a “recognition window”, no speech is recognized in this window of time. Rather, only audio signals can be received and stored by St. George during this window. Such received/stored speech signals are not interpreted or recognized until *after* the time window for receiving signals has closed.

Additionally, St. George at col. 8, lines 28-30, explicitly states that only when the “speech recognizer recognition window is closed at $T=T_w$ the aggregated speech sample is sent for speech recognition”. Thus, even though St. George’s uses the words “recognition window”, St. George at most teaches that audio signals are accepted during this window of time and are not sent for actual speech recognition (i.e., recognized) until after the window used to receive speech input has closed at time T_w . Thus, regardless of whether or not St. George calls a window of time for collecting speech samples that will not be recognized until some later time a “recognition window”, such data collection must be interpreted in context of St. George, which clearly teaches that no speech is recognized while collecting audio input.

This interpretation of St. George is also unambiguously illustrated in Fig. 8 of St. George.

Accordingly, when St. George indicates at lines 40-42 that “[w]hen $T=T_w$, the aggregated speech sample is captured, the recognition is closed, i.e., the recognizer is turned off”, it is respectfully submitted that St. George is merely

stating that the window for aggregating audio content has been closed, whereupon time recognition activity may begin.

For each of the above reasons, St. George does not teach or suggest “a speech recognition engine to recognize an utterance”, “the speech recognition engine being configured to actively listen for the utterance for a predetermined response time”. Moreover, appellant’s specification clearly describes the meaning of “actively listen”, as recited in claim 1.

The subject specification points out that “user interface 30 improves user interaction with the speech recognition system 20 by conveying to the user that the system is actively listening for a recognizable utterance or has heard and understood a recognizable utterance.” *An utterance cannot be recognizable or heard and understood until it has been interpreted.* Because St. George teaches that speech samples are not interpreted until after a window of time for receiving speech input has expired, St. George does not teach or suggest “a speech recognition engine to recognize an utterance” and “the speech recognition engine being configured to actively listen for the utterance for a predetermined response time”, as recited by claim 1.

Furthermore, for the reasons already stated in the APPEAL BRIEF, Salazar does not cure these discussed deficiencies of St. George.

Accordingly, the newest modification of St. George (i.e., “if speech filling up the entire time period from 0 to T_w was recognized in a known duration, such as T_p , the total time $T_w + T_p$ would read on the broadly claimed “predetermined response time”) is unsupported by the references of record.

For these reasons alone, the 35 USC §103 rejection of claim 1 is improper and should be overruled.

Additionally, since this new modification of St. George corresponds to a new point of argument that is not supported by the references of record, it appears that this rejection is maintained based on personal knowledge of the examiner. “When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 CFR §1.104(d)(2).

Such further evidentiary support of this 35 USC §103 rejection is respectfully requested, since a proper level of ordinary skill at the time of invention may not be represented by the information on which the examiner relies and which has not been made available to the appellant. If such further evidentiary support is not available, a prima facie case of obviousness has not been presented and the 35 USC rejection of claim 1 is improper and should be overruled.

Claim 1 further recites “the speech recognition engine being configured to enter a dormant state if the utterance is not recognized within the predetermined amount of time”.

In addressing these features at page 9, paragraph 3 of the ANSWER, it is asserted that “recognizing security information within a time limit, which would make the system unavailable if the utterance was not recognized within the time limit”. This is also a new point of argument. Previous actions rejected these

features based on arguments directed to St. George, col. 8, lines 40-51. The references of record do not teach or suggest the recited features of claim 1 for the following reasons, even in view of this new point of argument.

St. George at col. 8, lines 59-63 states that a user name and password can be used to provide access to an information system. Providing system access via user name and password pairs does not teach or suggest “the speech recognition engine being configured to enter a dormant state if the utterance is not recognized within the predetermined amount of time”. Additionally, for the reasons already stated in the APPEAL BRIEF, Salazar does not cure these discussed deficiencies of St. George.

Accordingly, and for these reasons alone, the 35 USC §103 rejection of claim 1 is improper and should be overruled.

In addressing **claims 9, 18, 23, 27, 33, and 34** the ANSWER maintains its respective rejections based on the latest (new) points of argument and new grounds of rejection that were argued with respect to claim 1. Appellant traverses these new points of argument and rejections for the reasons previously advanced with respect to the old grounds of rejection and for reasons advanced above with respect to the new grounds of rejection and the new points of argument.

Additionally, to further address the new points of argument presented with respect to claim 34, claim 34 recites “changing the graphic to indicate passage of the response time such that the graphic diminishes in size from an original size with the passage of time”, and “responsive to recognizing an utterance, presenting the graphic in the original size”. Appellant respectfully submits that the references of record do not teach or suggest these features for the reasons previously

advanced with respect to the old grounds of rejection and for reasons advanced above with respect to the new grounds of rejection and the new points of argument.

Additionally, even if St. George displays animation while collecting speech input and stops animation when speech input is not longer being collected, it has already been established (and admitted by the office) that St. George does not recognize any speech when the speech input is being collected. St. George does not animate anything when not collecting speech input. Since animation stops when St. George sends the collected data to the recognition engine, St. George may never “responsive to recognizing an utterance, presenting the graphic in the original size”, as claim 1 recites.

Additionally, claim 34 recites “responsive to expiration of the response time before the audible utterance has been recognized, emitting a second sound to indicate that the speech recognition system has entered a dormant state.” For the reasons already presented, the references of record do not teach or suggest this feature.

For instance, even if St. George teaches that audio is played during data collection, it has already been established that St. George does not recognize any data while collecting data or playing such audio. St. George only describes expiration of a time to input some unrecognized data that may at some other time be recognized. St. George has made it very clear that there is no actual speech recognition during speech data collection. In contrast to St. George, the features of claim 34 do include speech recognition when data is being collected. If time for recognition of an utterance expires, an audible sound is emitted to indicate that the system has entered a dormant state. Thus, St. George does not teach or suggest

these features of claim 34 in the context of speech recognition during speech collection.

Accordingly, the 35 USC §103 rejection of claim 34 is improper and should be overruled.

A Reference Must be Relied on to Some Extent for Teaching
the Level of Ordinary Skill at the Time of Invention

Claim 1 recites “the user interface being configured to: (a) play an audible sound indicating recognition of the utterance; (b) display a countdown graphic that changes with lapsing of the predetermined response time; (c) restart the countdown graphic in the event the speech recognition engine recognizes the utterance.”

In addressing these features, the ANSWER at page 10, paragraph 2, admits that these features are not taught or suggested by the references of record. Instead, the ANSWER concludes, without any showing of evidence, that the recited features would have been obvious to an ordinary person of skill in the art at the time of invention. Since specific portions of a cited reference or other evidence have not been supplied to support this conclusion, it appears that this rejection is maintained based on personal knowledge of the examiner.

“When a rejection in an application is based on facts within the personal knowledge of an employee of the office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 CFR §1.104(d)(2). The November 20, 2001 response requested such further

evidentiary support (i.e., either a portion of a reference or a sworn affidavit from the examiner stating that he/she is such a person of ordinary skill in the art at the time of invention) of this conclusion of obviousness, since no references were used to support this assertion.

The ANSWER provides a new point of argument by attempting to provide support for the proposed modification of the cited references to arrive at the recited features of claim 1 by referring to a portion of MPEP §2144 that describes what type of information can be relied on in an obviousness rejection. However, appellant respectfully submits that reciting a portion of the MPEP that does not teach or suggest the rejected features does not remove the office's initial burden to present a prima facie case of obviousness when rejecting a claim under 35 USC §103(a). Rather, actual evidentiary support is required to properly maintain a rejection of claim 1 features under 35 USC §103(a). If such further evidentiary support is not available, a prima facie case of obviousness has not been presented and the 35 USC rejection of claim 1 is improper and should be overruled.

Again, in view of the ANSWER's failure to provide proper evidentiary support of this rejection, if this rejection is maintained on a similar basis, actual evidentiary support of the level of ordinary skill in the art at the time of invention is required and requested, since such level of ordinary skill may not be represented by the information on which the examiner relies.

With respect to the ANSWER's rejection of the remaining pending claims, appellant traverses these rejections for the reasons previous advanced with respect to the old grounds of rejection and for reasons advanced above with respect to the new grounds of rejection and the new points of argument.

Conclusion

The appellant respectfully considers this application to be in condition for allowance and respectfully requests the Board to overturn the final rejection and that this application be passed to allowance.

Respectfully submitted,

Date: 7/18/02

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